

REMARKS

Claims 15-29 are pending in the present application. Claims 15 and 21 were amended in this response. No new matter was introduced as a result of the amendment. Favorable reconsideration is respectfully requested.

Claim 15 was rejected under 35 U.S.C. §102(e) as being anticipated by Willkie et al. (US Patent 5,956,651). Claims 16-19, 21-25 and 27-29 were rejected under 35 U.S.C. §103(a) as being unpatentable over Willkie et al. (US Patent 5,956,651) in view of Lueh (US Pub 2002/0144240). Claims 20 and 26 were rejected under 35 U.S.C. §103(a) as being unpatentable over Willkie et al. (US Patent 5,956,651) in view of Lueh (US Pub 2002/0144240), and further in view of Atkinson et al. (US Pub 2002/0012329). Applicants respectfully traverse this rejections.

Specifically, the cited art, alone or in combination fails to teach a telecommunication module directly connected to a wireless mobile communication network as recited in claim 15 and similarly recited in claim 21. Willke discloses a PCMCIA card that serves as an interface between a mobile phone and a computer (col. 5, lines 22-27, 42-55). Willke is completely silent regarding the card being directly connected to a wireless mobile communication network, and being able to perform at least one telecommunication activity of creating, setting up, implementing, monitoring and terminating a telecommunication connection with the wireless mobile communication network. Regarding Lueh, the reference does not even address telecommunication capabilities – the Atkinson references are silent regarding these features as well.

Furthermore, regarding claim 21, applicants submit that there is no teaching, suggestion or motivation for one of ordinary skill in the art to combine the Willke and Lueh references in the manner suggested in the Office Action. As stated above, Lueh does not even mention telecommunication protocols, and the JAVA system is configured to address overhead issues pertaining to the loading of native code into a virtual memory ([0005]). There is nothing that would teach or suggest incorporating the JAVA object method of Lueh with the disclosure in Willke.

In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28

U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). "If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

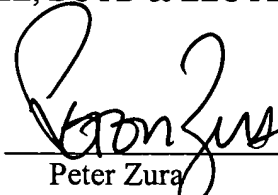
In light of the above, Applicants respectfully submit that claims 15-29 are both novel and non-obvious over the art of record. Applicants respectfully request that a timely Notice of Allowance be issued in this case. If any additional fees are due in connection with this

application as a whole, the Examiner is authorized to deduct such fees from deposit account no. 02-1818. If such a deduction is made, please indicate the attorney docket no. (0112740-1019) on the account statement.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Peter Zura

Reg. No. 48,196

Customer No.: 29177

Phone: (312) 807-4208

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